

**REMARKS**

In a final Office Action dated October 2, 2008 ("*Office Action*"), the Examiner indicated that claims 21-31 are allegedly not entitled to the filing date of prior U.S. Application No. 08/388,107; objected to claims 24-25 due to alleged informalities; rejected claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,659,616 to Sudia ("*Sudia*") in view of U.S. Patent Publication No. 2002/0144108 to Benantar ("*Benantar*"); rejected claims 24-25 under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of U.S. Patent No. 5,956,408 to Arnold ("*Arnold*"); rejected claim 28 under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of U.S. Patent No. 5,537,618 to Boulton et al. ("*Boulton*"); rejected claims 29-31 under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of Official Notice; and rejected claims 34-35 under U.S.C. §103 as being unpatentable over *Sudia* in view of *Benantar* in further view of U.S. Patent No. 5,978,567 to Rebane et al. ("*Rebane*").

No amendments are made herein. For the Examiner's convenience, Applicants have included in this paper a listing of the pending claims. Applicants respectfully traverse the aforementioned rejections and request reconsideration based on the following remarks. In addition, Applicants do not necessarily agree with or acquiesce in the Examiner's characterization of the claims or the prior art, even if those characterizations are not addressed herein.

**Priority**

As an initial matter, in the Office Action, the Examiner indicated that certain recited claim elements are not disclosed in U.S. Application No. 08/388,107 ("the '107 application"). The instant application is a continuation of U.S. Application No. 09/426,764 (now U.S. Patent No. 6,658,568), which is a continuation of U.S. Application No. 09/398,665, which is a continuation of U.S. Application No. 08/699,721, which is a continuation-in-part of the '107 application.

Therefore, as the instant application is a continuation application derived from a continuation-in-part of the '107 application, the Examiner refused to grant priority to the '107 application.

Applicants respectfully submit that the Examiner's action is inappropriate in this case.

M.P.E.P. §201.08 provides that:

"[u]nless the filing date of the earlier nonprovisional application is actually needed, for example, in the case of an interference or to overcome a reference, there is no need for the Office to make a determination as to whether the requirement of 35 U.S.C. 120, that the earlier provisional application discloses the invention of the second application in the manner provided by the first paragraph of 35 U.S.C. 112, is met and whether a substantial portion of all of the earlier nonprovisional application is repeated in the second application in a continuation-in-part situation. Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of the an earlier nonprovisional application if the alleged continuation-in-part applications complies with the other requirements of 35 U.S.C. 120 and 37 C.F.R. 1.78."

M.P.E.P §201.08. (Emphasis added).

In other words, an applicant can claim the benefit of an earlier non-provisional application in a continuation-in-part application if certain administrative details are satisfied and so long as there is no intervening reference. See M.P.E.P. §201.08.

In the Office Action, the Examiner states that the disclosure of the '107 application "fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application," and notes that this determination is proper as an allegedly intervening reference, *Benantar*, is now applied in rejecting the claims. Office Action, page 3. Not only is the Examiner's determination wrong, but her comments to that effect are improper for at least the following reasons.

The '107 application has a filing date of February 13, 1995. U.S. Application No. 08/699,721 (the '721 application), the continuation-in-part application from which the instant application derives, has a filing date of August 12, 1996. None of the references relied on by the Examiner in the Office Action, including *Benantar*, are intervening references, because they

did not become publicly available unit after the '107 application was filed and before the filing of the '721 continuation-in-part application. *Benantar* especially is not an intervening reference as it was filed on March 29, 2001 and published in October 3, 2002 -- neither of which falls in that period.

Accordingly, pursuant to M.P.E.P. §201.08, it is not appropriate for the Examiner in this case to make any determination as to whether the claims of this application are entitled to the prior date of the '107 application, and this portion of the Office Action should be withdrawn.

### **Objections**

The Examiner objected to claims 24-25 because of alleged informalities. Applicants submit, however, that the informalities noted by the Examiner appear to be caused by a scanning error, which rendered the number of claim 24 unreadable. For the Examiner's convenience, Applicants have included a listing of claims with this paper, which clearly shows claim 24. Accordingly, Applicants respectfully request that the Examiner withdraw the objections to claims 24-25.

### **Claim Rejections Under 35 U.S.C. §103**

Applicants respectfully traverse the rejection of claims 21-41 under 35 U.S.C. §103 because a *prima facie* case of obviousness has not been established with respect to these claims.

#### **Claims 21-23, 26-27, 32-33, and 36-41**

Claims 21-23, 26-27, 32-33, and 36-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar*. Applicants respectfully submit that the Examiner has made an improper rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a) because *Benantar* is not prior art.

According to the M.P.E.P. "[a] 35 U.S.C. §103 rejection is based on 35 U.S.C. §102(a), §102(b), §102(e), etc. depending on the type of prior art reference used and its publication or

issue date.” M.P.E.P. §2141.01. In other words, a reference must first be prior art under one of the sections of 35 U.S.C. §102 in order to be used as a prior art reference under 35 U.S.C.

§103. The publication date of *Benantar* is October 3, 2002. As discussed above, however, the instant application claims priority to the ‘107 application, filed February 13, 1995, and the ‘721 application, a continuation-in-part of the ‘107 application filed August 12, 1996. Applicants submit that because the publication date of *Benantar* does not precede the filing dates of either the ‘107 application or the ‘721 application (February 13, 1995, and August 12, 1998, respectively), *Benantar* cannot be considered a prior art reference under either of 35 U.S.C. §§102(a) or 102(b).

With respect to 35 U.S.C. §102(e), the earliest effective U.S. filing date of *Benantar* is March 29, 2001. Since the earliest effective U.S. filing date of *Benantar* does not precede the filing dates of either the ‘107 application or the ‘721 application, to which benefit of priority in the instant application is claimed, *Benantar* cannot be considered a prior art reference under 35 U.S.C. §102(e).

As discussed above, *Benantar* does not qualify as prior art under any section of 35 U.S.C. §102. Therefore, the Examiner has made an improper rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a).

#### Claims 24-25

Claims 24-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of *Arnold*. As discussed above with respect to the Examiner’s rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a), *Benantar* is not prior art. Therefore, the Examiner has made an improper rejection of claims 24-25 under 35 U.S.C. §103. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 24-25 under 35 U.S.C. §103(a).

Claim 28

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of *Boulton*. As discussed above with respect to the Examiner's rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a), *Benantar* is not prior art. Therefore, the Examiner has made an improper rejection of claim 28 under 35 U.S.C. §103. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 28 under 35 U.S.C. §103(a).

Claims 29-31

Claims 29-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Sudia* in view of *Benantar* in further view of Official Notice. As discussed above with respect to the Examiner's rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a), *Benantar* is not prior art. Therefore, the Examiner has made an improper rejection of claims 29-31 under 35 U.S.C. §103. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 29-31 under 35 U.S.C. §103(a).

Moreover, regarding the Examiner's assertion that certain elements recited in the claims "are well known features [and] are common knowledge at the time of the invention," to the extent that the Examiner is taking Official Notice that such limitations are "well known," Applicant reminds the Examiner that when relying on common knowledge, or taking Official Notice, to support a rejection under 35 U.S.C. §103, "the [Examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test. *In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697. See also M.P.E.P. §2144.03. Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and an explanation to support the finding. See 37 C.F.R. §1.104(d)(2). If the Examiner maintains the rejection by relying on the position that elements recited in claims 29-31 "are well known features [and] are common knowledge at the time of the invention," Applicant

asks that the Examiner provide additional evidentiary support, either in the form of a reference or affidavit, to support this statement.

Claims 34-35

Claims 34-35 stand rejected claims 34-35 under U.S.C. §103 as being unpatentable over *Sudia* in view of *Benantar* in further view of *Rebane*. As discussed above with respect to the Examiner's rejection of claims 21-23, 26-27, 32-33, and 36-41 under 35 U.S.C. §103(a), *Benantar* is not prior art. Therefore, the Examiner has made an improper rejection of claims 34-35 under 35 U.S.C. §103. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 34-35 under 35 U.S.C. §103(a).

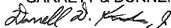
Conclusions

In view of the foregoing remarks, Applicants submit that the pending claims are neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

  
Darrell D. Kinkead, Jr.

Dated: March 2, 2009

By: Reg. No. 57,960  
Linda J. Thayer  
 Reg. No. 45,681